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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,134	03/29/2001	Maria A. Himmel	AUS9-2001-0190-US1	5631

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EXAMINER

CHO, UN C

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 06/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,134

Applicant(s)

HIMMEL ET AL.

Examiner

Un C Cho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11-21, 23, 25-35, 37 and 39-42 is/are rejected.
- 7) ☒ Claim(s) 8, 10, 22, 24, 36 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 – 4, 7, 9, 11 – 13, 15 – 18, 21, 23, 25 – 27, 29 – 32, 35, 37, 39 – 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsunami et al. (US 6,735,431).

Regarding claim 1, Tsunami teaches detecting a registration of the radio-communication terminal with a base station (Tsunami, Col. 11, line 65 through Col. 12, line 2), initiating a user preferred schedule for pushing advertisements to the radio-communication terminal subsequent to a detection of the registration (Tsunami, Col. 11, lines 1 – 67 through Col. 12, line 2) and pushing the advertisement to the radio-communication terminal in accordance with the user preferred schedule (Tsunami, Col. 12, lines 4 – 14 and 60 – 67).

Regarding claim 2, Tsunami teaches verifying a reception of the signal by the radio-communication terminal in response to a reception of a responsive command from the radio-communication terminal that indicates a reception of the advertisement by the radio-communication terminal (Tsunami, Col. 18, lines 25 – 37).

Regarding claim 3, Tsunami teaches rewarding a user of the radio-communication terminal in response to a responsive command from the radio-communication terminal that indicates a reception of the advertisement by the radio-communication terminal (Tsunami, Col. 18, lines 37 – 42 and Col. 18, line 65 through Col. 19, line 4).

Regarding claim 4, Tsunami teaches establishing a communication link between the radio-communication terminal and a telecommunication device associated with an advertiser represented in the advertisement in response to a reception of a contact command indicating a desire of a user of the mobile station for an establishment of the communication link (Tsunami, Col. 18, lines 30 – 37).

Regarding claim 7, Tsunami teaches determining a location of the radio-communication terminal and matching a location of an advertiser represented in the advertisement with the location of the radio-communication terminal (Tsunami, Col. 11, line 65 through Col. 12, lines 4 – 14 and 60 – 67).

Regarding claim 9, Tsunami teaches retrieving a user profile corresponding to the radio-communication terminal and matching a good or a service represented in the advertisement with the user profile (Tsunami, Col. 11, line 57 through Col. 12, line 67).

Regarding claim 11, Tsunami teaches pushing an advertisement to the radio-communication terminal subsequent to a registration of the radio-communication terminal with a base station (Tsunami, Col. 11, line 65 through Col. 12, line 2, Col. 12, lines 4 – 14 and 60 – 67) and verifying a reception of the

advertisement by the radio-communication terminal in response to a reception of a responsive command from the radio-communication terminal that indicates the reception of the advertisement by the radio-communication terminal (Tsunami, Col. 18, lines 25 – 37).

Regarding claim 12, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 13, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Regarding claim 15, the claim is interpreted and rejected for the same reason as set forth in claim 1.

Regarding claim 16, the claim is interpreted and rejected for the same reason as set forth in claim 2.

Regarding claim 17, Tsunami teaches transmitting a responsive command in response to a reception of the signal (Tsunami, Col. 18, lines 25 – 37) and rewarding a user of the radio-communication terminal in response to the responsive command from the radio-communication terminal (Tsunami, Col. 18, lines 37 – 42 and Col. 18, line 65 through Col. 19, line 4).

Regarding claim 18, Tsunami teaches transmitting a responsive command in response to a reception of the signal, establishing a communication link between the radio-communication terminal and a telecommunication device associated with an advertiser represented in the advertisement in response to a reception of the responsive command (Tsunami, Col. 18, lines 25 – 37).

Regarding claim 21, the claim is interpreted and rejected for the same reason as set forth in claim 7.

Regarding claim 23, the claim is interpreted and rejected for the same reason as set forth in claim 9.

Regarding claim 25, the claim is interpreted and rejected for the same reason as set forth in claim 11.

Regarding claim 26, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 27, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Regarding claim 29, the claim is interpreted and rejected for the same reason as set forth in claim 1.

Regarding claim 30, the claim is interpreted and rejected for the same reason as set forth in claim 2.

Regarding claim 31, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 32, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Regarding claim 35, the claim is interpreted and rejected for the same reason as set forth in claim 7.

Regarding claim 37, the claim is interpreted and rejected for the same reason as set forth in claim 9.

Regarding claim 39, the claim is interpreted and rejected for the same reason as set forth in claim 15.

Regarding claim 40, the claim is interpreted and rejected for the same reason as set forth in claim 3.

Regarding claim 41, the claim is interpreted and rejected for the same reason as set forth in claim 4.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5, 6, 14, 19, 20, 28, 33, 34 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsunami in view of Jokinen et al. (US 2002/0095333).

Regarding claim 5, Tsunami teaches rewarding a user of the mobile communication instrument when there is a communication link between the mobile communication instrument and the advertiser (Tsunami, Col. 18, lines 37 – 42 and Col. 18, line 65 through Col. 19, line 4). However, Tsunami fails to teach rewarding a user when the communication link results in a purchase of a good or a service from the advertiser. In contrast, Jokinen teaches rewarding a user after a purchase of a corresponding advertisement product (Jokinen, Page 6, Paragraph 0055, lines 3 - 32). Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to provide the teaching of Jokinen to Tsunami to provide a method of dynamically pricing and/or generating an advertising message to be sent to at least one of a plurality of mobile terminal users.

Regarding claim 6, Tsunami fails to teach providing a credit to an account of the user of the mobile station when pushing the advertisement to the mobile station. However, Jokinen teaches providing a refund to an account of the user of the mobile phone upon validation of the electronic coupon sent to the user (Jokinen, Page 6, Paragraph 0057, lines 1 – 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Jokinen to Tsunami to provide a method of dynamically pricing and/or generating an advertising message to be sent to at least one of a plurality of mobile terminal users.

Regarding claim 14, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Regarding claim 19, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Regarding claim 20, the claim is interpreted and rejected for the same reason as set forth in claim 6.

Regarding claim 28, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Regarding claim 33, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Regarding claim 34, the claim is interpreted and rejected for the same reason as set forth in claim 6.

Regarding claim 42, the claim is interpreted and rejected for the same reason as set forth in claim 5.

Allowable Subject Matter

5. Claim 8, 10, 22, 24, 36 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 8, Tsunami (US 6,735,431) and Jokinen et al. (US 2002/0095333), either alone or in combination fail to teach determining a first service area base station; determining a second service area of any potential handoff base station; and matching a location of an advertiser represented in the advertisement with the first service area or the second service area.

Regarding claim 10, Teshima (US 6,735,431) and Jokinen et al. (US 2002/0095333), either alone or in combination fail to teach compiling a list of advertisements previously transmitted to mobile station prior to transmitting the advertisement to the mobile station and transmitting the advertisement that is absent from the list.

Regarding claim 22, the claim is interpreted and objected for the same reason as set forth in claim 8.

Regarding claim 24, the claim is interpreted and objected for the same reason as set forth in claim 10.

Regarding claim 36, the claim is interpreted and objected for the same reason as set forth in claim 8.

Regarding claim 38, the claim is interpreted and objected for the same reason as set forth in claim 10.

Response to Arguments

5. Applicant's arguments with respect to claims 1 – 7, 9, 11 – 21, 23, 25 – 35, 37 and 39 – 42 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Un C Cho whose telephone number is (703)305-8725.

The examiner can normally be reached on M ~ F 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (703)308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Un C Cho *UC* 6/15/04
Examiner
Art Unit 2682


LEE NGUYEN
PRIMARY EXAMINER